

REMARKS

Attention is drawn to the fact that claims 13-16 and 33-38 have not been cancelled and are still pending, but are in withdrawn status. The Examiner had indicated in the last Office Action that they will be rejoined if the elected claims are found to be allowable, and therefore, they were not cancelled.

The rejection of claims 1-12, 23, 24 and 26-32 under 35 USC § 102 over Fu is respectfully traversed.

Fu relates to titanium dioxide coated substrate pearlescent pigments in general. It is desirable that the titanium dioxide be in the rutile crystalline form because rutile has a higher refractive index, stronger luster in color effects and higher outdoor weathering stability than other crystalline forms of the titanium dioxide. To achieve such a crystalline form, it was necessary to use either a tin or iron layer, as described in the opening paragraphs of the reference. Fu is based on the discovering that rutile layers could be obtained by depositing the titanium in a particular way. That titanium dioxide can be placed on any platelet substrate including natural or synthetic mica, talc, kaolin, sericite, glass, silica, alumina, as well as other platelets. Natural mica having a particle size of 5-400 microns, more preferably 5-100 microns, and most preferably 5-50 microns, is preferred. The working examples in this patent as showed the use of natural mica of either 10-50 microns or 5-15 microns. Fu discloses that a promising area of application is in areas such as cosmetics, food stuffs, and food contact applications but there is no disclosure or exemplification in this patent of any cosmetic composition containing a coated mica nacreous pigment in which the mica is a synthetic mica having a particle size ranging from about 150 to about 500 microns. For example, there is no teaching of any cosmetic composition selected from the groups set forth in claim 26 of this application.

Fu is not an anticipatory reference. It is well established that the disclosure of a genus in the prior art is not a disclosure of every species that is a member of that genus. *In re Baird*, 29 USPQ2d 1550 (Fed. Cir. 1994). Anticipation is also not established if it is necessary to pick, choose and combine various portions of the disclosure when reading a claim on something disclosed in a reference. *In re Arkley*, 172 USPQ 524, 526 (CCPA 1972); Accord, Ex parte Beuther, 71 USPQ2d 1313 (BPAI 2003) (Unpublished).

In the case of Fu, at best a genus is disclosed and there are three selections which must be made when trying to read the patent of the instant claims. First, synthetic mica must be selected from among the eight possible specifically substrates disclosed. Secondly, a particle size within the range of 150-1000 μm must be selected even though the reference indicates that the preferable range is 5-100 μm and even most preferably, the size should be 5-50 μm . Third, a cosmetic application as opposed to a food stuff or food contact application must be chosen. Both because there is only a genus disclosure and because selections must be made, a Section 102 rejection is untenable.

The inclusion of claims 4-9, 27, 30 and 31 in this anticipation rejection is clearly improper since the previous Office Action correctly admitted the features of these claims were not present in Fu.

The Office Action asserts on page 3 that the Fu composition inherently have the same physio-chemical properties such as gloss, etc. because these properties are "inherent" and vary with the composition of a nacreous pigment, citing the Defossez and Kimura patents. Had these claims merely recited that that the pigment had a gloss, applicants could have agreed since the fact that the material had some degree of gloss is an inherent characteristic but that is not what is being claimed. For example, claim 4 says that the coated synthetic mica has a gloss of at least 40%. Reliance on inherency is allowed only

when the characteristic is certain. *In re Robertson*, 49 USPQ2d 1949, 1949 (Fed. Cir. 1999) ("inherency is not established by probabilities or possibilities"). This requirement has not been met here as there has been no attempt to show that a material of any reference has a 40% or better gloss rather than a 10% gloss. Further, the Defossez and Kimura patents relate to natural mica and have no teaching about synthetic mica, and therefore cannot support to assertion of inherency.

The rejection of claims 1-12, 23, 24 and 26-32 under 35 USC § 103 over Fu combined with Calello is respectfully traversed.

The Fu patent relates to a new way to make a rutile titanium dioxide coating. That titanium dioxide can be placed on any platelet substrate including natural or synthetic mica, talc, kaolin, sericite, glass, silica, alumina, as well as other platelets. Natural mica having a particle size of 5-400 microns, more preferably 5-100 microns, and most preferably 5-50 microns, is preferred. The working examples in this patent show the use of natural mica of either 10-50 microns or 5-15 microns. Fu thus teaches that smaller is better.

Fu is confirmatory of the knowledge in the art that small natural micas, i.e., those less than about 150 microns particle size, are preferably used in the preparation of nacreous pigments. While synthetic mica has solved some of the visual and textural related problems associated with the coated natural micas, the small particle size synthetic micas were still deficient in gloss and brightness properties. They show a tendency to exhibit an increase in opacity and reduced transparency, which hide the more desirable properties of the nacreous pigments such as glint and sparkle. There is nothing in Fu, or any of the other cited art, which suggests changing the particle size of synthetic micas might overcome the deficient gloss and brightness properties.

The present invention is based, *inter alia*, on the discovery that improved transparency, superior gloss, glint and brightness, better compressibility and higher purity, as indicated by a higher degree of whiteness, can be realized by employing a synthetic mica having a particle size of about 150 to 1000 microns as the substrate. The rejection is based, at least in part, of the assumption that natural and synthetic micas are equivalent. But if that assumption was correct, the same improvement would be realized without regard to whether the mica was natural or synthetic, and that is not true, as shown in the working examples of this application. The improvements realized with large particle size synthetic mica was not seen when natural mica was used. Indeed, the large particle size synthetic mica gave better properties than the preferred small particle size natural mica of Fu. In application example 1, mica having a particle size which range 150-750 microns with a mean particle size from 250 to 360 microns which was either natural (samples G-H) or synthetic (samples A-C), and natural or synthetic small size (25-95 μm with a mean of 40-60 μm)(samples D-F) are compared in the table. In all categories tested, the large particle size synthetic mica was superior to the corresponding large particle size natural mica and both the natural and synthetic small particle size mica. Likewise, the comparison tables in examples 3, 6, 9, 12, 16, 19 and 20 compared 150-750 micron synthetic micas (the "A" samples) with 20-95 micron synthetic micas (the "B" samples) and 150-750 micron natural mica (the "C" samples). In every case and in every parameter tested, the large particle size synthetic mica was superior to the large particle size natural mica and small particle size synthetic mica. It is respectfully submitted that this superiority is surprising, unexpected and unpredictable. This is particularly true since Fu teaches that small is better than large and the finding that the opposite is true with synthetic mica is directly contrary to this reference.

Calello was cited to show a lipstick which has gloss and shine, and that high gloss is desirable. It is asserted that it would be obvious to one skilled in the art to modify that composition to use the mica coated substrate of Fu. The Office Action states on page 7 that Fu is being relied upon to show that particle size has a relationship to gloss or shine or texture but there is no such teaching or suggestion as of any type of mica, and particularly with respect to large size synthetic mica. It thus appears that the reliance is based on an unspoken assertion that degree of gloss in the claims under consideration is "inherent". That is improper since reliance on inherency is allowed only when the characteristic is certain. *In re Robertson*, 49 USPQ2d 1949, 1949 (Fed. Cir. 1999) ("inherency is not established by probabilities or possibilities"). Thus, a critical underpinning for the rejection is absent. Moreover, as pointed out above, Fu teaches a preference for natural micas and that small is better than large, neither of which provide any basis for one skilled in the art to believe that the large particle size synthetic mica would provide better properties.

As previously pointed out, the large particle size synthetic mica gives better gloss, brightness, glean, transparency and whiteness than large particle size natural mica or small size synthetic mica, and this result is surprising and unexpected. One skilled in the art would not predict that the incorporation of a synthetic mica would give any different gloss and shine properties than natural mica, would not predict that large is better than small, and would therefore would use natural mica of small particle size as recommend by Fu if such a coated platelet was being incorporated into the Calello lipstick. The fact that better gloss can be achieved is surprising, unexpected, unpredictable and unobvious.

Claims 1-12, 17, 18, 23, 24 and 26-32 were rejected under 35 USC § 103 over Fu in view of Watanabe. The rejection is respectfully traversed.

Because Watanabe teaches that a cosmetic composition containing one or more inorganic/organic particulates or colorants may provide transparent pigments of various colors having good transparency, it is asserting to be obvious to use a Fu product. However, the Examiner acknowledges that Fu fails to disclose a composition having an increased transparency of at least 10%. The claimed invention uses coated synthetic mica of large particle size to achieve the improved transparency, etc. rather than colorants. Watanabe uses natural mica, and there is no suggestion of using synthetic mica. A fatal flaw in this rejection, as in the prior rejection, is the unspoken assertion that there is a teaching or suggestion in either Fu or Watanabe that a large particle size synthetic mica will provide improved transparency even though there is no such teaching or suggestion in either reference. Neither Fu or Watanabe indicate a large particle size synthetic mica will achieve these results and indeed, Fu prefers the use of a small particle size natural mica and also teaches the smaller the better. Clearly, therefore, the invention is surprising, unexpected, unpredictable and unobvious.

Claims 1, 18, 19 and 31 were rejected under 35 USC § 103 over Fu in view of Kimura. In this rejection, the Examiner acknowledges that Fu fails to disclose a composition in which a synthetic mica having an increased brightness of at least 5% is used, but states that a cosmetic composition having excellent properties is well known as shown by Kimura. In this rejection, as in the prior rejections, there is an assumption that if a property is desirable, Fu teaches that the claimed pigment has that property. Once again, there is a complete failure in Fu to teach or suggest that the claimed property is achieved. No proper basis for asserting that the property is inherent has been established. Moreover, "a retrospective conclusion that an unstated advantage would follow from the suggested combinations is not a substitute teaching or suggestion which supports the selection and use of the various elements in the particular claim combination.... 'That which may be

inherent is not necessarily known.” *In re Newell* 13 USPQ2d 1248 (Fed Cir 1989). Here also, nothing in either reference teaches or suggests that the excellent properties achieved can be realized by using a large particle size synthetic mica in place of a large particle size natural mica and indeed, Fu teaches that it is preferable to use small particle size natural mica as opposed to either the large particle size natural material or any synthetic mica and also that small particle size is better than large particle size. Fu thus teaches away from the present invention. Clearly the results achieved in the present application are surprising, unexpected, unpredictable and unobvious.

Claims 1, 21, 22 and 25 were rejected under 35 USC § 103 over Fu in view of Miyoshi. This rejection is respectfully traversed.

In this rejection, the Office Action acknowledges that Fu fails to disclose a composition with synthetic fluorophlogopite mica. Miyoshi is asserted to disclose a powder based on substrate particles such as synthetic fluorophlogopite mica coated with micronized metal oxide particles. However, Miyoshi discloses the particle size of the substrate, be it mica or something else, should be 1-50 μm (col. 3., lines 14-20). Fu’s most preferred range is 5-50 μm so that both references suggest the maximum particle size should be 50 μm . This teaching also reinforces Fu’s teaching that small is better and the combined teachings would lead the skilled person away from the present invention. In this rejection also, there is no teaching or suggestion that the use of the use of the coated large particle size synthetic mica will provide surprising, unexpected, and unpredictable properties compared to the use of a coated small or large particle size natural mica, or small particle size synthetic mica. It is respectfully submitted that this rejection should also be withdrawn.

In view of all of the foregoing, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

By /Edward A. Meilman/
Edward A. Meilman
Registration No.: 24,735
DICKSTEIN SHAPIRO LLP
1177 Avenue of the Americas
New York, New York 10036-2714
(212) 277-6500
Attorney for Applicant